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In re Application of
KEIGHTLEY *et al*
Application No.: 10/536,615
PCT No.: PCT/AU2003/001596
International Filing Date: 01 December 2003
Priority Date: 29 November 2002
Attorney Docket No.: 1849023US1ANP
For: DUAL LOCK APPARATUS

DECISION

This is a decision on the petition under 37 CFR 1.78(a)(3) filed 06 August 2007 which is hereby **DISMISSED** without prejudice.

A petition for acceptance of a claim for late priority under 37 CFR 1.78(a)(3) is only applicable to those applications filed on or after November 29, 2000. Further, the petition is appropriate only after the expiration of the period specified in 37 CFR 1.78(a)(2)(ii). The petition under 37 CFR 1.78(a)(3) must be accompanied by:

- (1) the reference required by 35 U.S.C. § 120 and 37 CFR 1.78(a)(2)(i) of the prior-filed application, unless previously submitted;
- (2) the surcharge set forth in § 1.17(t); and
- (3) a statement that the entire delay between the date the claim was due under 37 CFR 1.78(a)(2)(ii) and the date the claim was filed was unintentional. The Director may require additional information where there is a question whether the delay was unintentional.

The petition does not comply with item (1).

Applicants submitted an amendment that states, in part: "[t]his is a continuation-in-part of U.S. Application Serial No. 10/276,547, now Patent No. 6,964,183 having a 371(c) date of November 14, 2002; the application being a National Stage filing of PCT/AU01/00579 having an international filing date of May 18, 2001, which application claims priority from Australian Application PQ7576, filed May 18, 2000; the entire disclosures of which are incorporated herein by reference."

The reference to add the prior-filed applications is not acceptable as drafted since it improperly incorporates by reference the prior-filed applications. An incorporation by reference statement added after an application's filing date is not effective because no new matter can be added to an application after its filing date (see 35 U.S.C. § 132(a)).

If an incorporation by reference statement is included in an amendment to the specification to add a benefit claim under 35 U.S.C. § 120 after the filing date of the application, the amendment would not be proper. When a benefit claim under 35 U.S.C. § 120 is submitted after the filing of an application, the reference to the prior application cannot include an incorporation by reference statement of the prior application. See Dart Industries v. Banner, 636 F.2d 684, 207 USPQ 273 (C.A.D.C. 1980). Note MPEP §§ 201.06(c) and 608.04(b).

Moreover, applicants may not add a foreign priority benefit claim to a national stage application submitted under 35 U.S.C. 371. Foreign priority in a national phase application is governed by 35 U.S.C. 365(b), which requires, *inter alia*, compliance with the PCT and PCT Regulations. In the present case, the priority claim to Australian Application PQ7576 does not comply with PCT Rules 4.10 and 26bis. Thus, the request to add Australian Application PQ7576 as a foreign priority can not be accepted in this national phase application.

Any further correspondence with respect to this matter may be filed electronically via the USPTO EFS-Web, by facsimile to the Office of PCT Legal Administration at (571) 273-04559, or if mailed addressed to Mail Stop PCT, Commissioner for Patents, Office of PCT Legal Administration, P.O. Box 1450, Alexandria, Virginia 22313-1450, with the contents of the letter marked to the attention of the Office of PCT Legal Administration.

Any questions concerning this matter may be directed to James Thomson at (571) 272-3302.



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